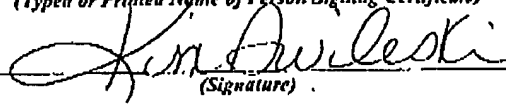


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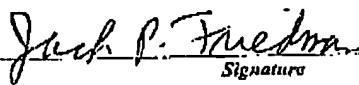
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|   |                                 |                                |                                      |
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| <b>CERTIFICATE OF TRANSMISSION BY FACSIMILE (37 CFR 1.8)</b>  |                                 |                                | <b>Docket No.</b><br>RSW920010033US1 |
| Applicant(s): Doreen L. Galli   |                                 |                                |                                      |
| <b>Application No.</b><br>09/870,223  | <b>Filing Date</b><br>5/30/2001 | <b>Examiner</b><br>Kang, Insum | <b>Group Art Unit</b><br>2193        |
| Invention: METHOD AND APPARATUS FOR TAILORING VOICE PROMPTS OF AN INTERACTIVE VOICE RESPONSE SYSTEM   |                                 |                                |                                      |
| <p>I hereby certify that this _____ <u>Appeal Brief (26 pages) + Transmittal 1 pg.</u><br/>(Identify type of correspondence)</p> <p>is being facsimile transmitted to the United States Patent and Trademark Office (Fax. No. <u>571-273-8300</u>)</p> <p>on <u>9/21/2005</u><br/>(Date)</p> <p style="text-align: right;"><u>Kim Dwileski</u><br/>(Typed or Printed Name of Person Signing Certificate)<br/><br/>(Signature)</p> <p style="text-align: center;">Note: Each paper must have its own certificate of mailing.</p> |                                 |                                |                                      |

SEP 21 2005

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|---|-------------------------------|--------------------------------|--|-------------------------------|--------------------------------------|--|
| <b>TRANSMITTAL OF APPEAL BRIEF (Large Entity)</b>   |                               |                                |  |                               | Docket No.<br><b>RSW920010033US1</b> |  |
| In Re Application Of: <b>Doreen L. Galli</b>  |                               |                                |  |                               |                                      |  |
| Application No.<br><b>09/870,223</b>  | Filing Date<br><b>5/30/01</b> | Examiner<br><b>Kang, Insun</b> | Customer No.<br><b>30449</b>   | Group Art Unit<br><b>2193</b> | Confirmation No.                     |  |
| Invention: <b>METHOD AND APPARATUS FOR TAILORING VOICE PROMPTS OF AN INTERACTIVE VOICE RESPONSE SYSTEM</b>  |                               |                                |  |                               |                                      |  |
| <u>COMMISSIONER FOR PATENTS:</u>  |                               |                                |  |                               |                                      |  |
| Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed on<br><b>7/21/2005</b>   |                               |                                |  |                               |                                      |  |
| The fee for filing this Appeal Brief is: <b>\$500.00</b>  |                               |                                |  |                               |                                      |  |
| <input type="checkbox"/> A check in the amount of the fee is enclosed.  |                               |                                |  |                               |                                      |  |
| <input checked="" type="checkbox"/> The Director has already been authorized to charge fees in this application to a Deposit Account.   |                               |                                |  |                               |                                      |  |
| <input checked="" type="checkbox"/> The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. <b>09-0457(IBM)</b>    |                               |                                |  |                               |                                      |  |
| <input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.   |                               |                                |  |                               |                                      |  |
| <b>WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.</b> |                               |                                |  |                               |                                      |  |
| <br>_____<br><i>Signature</i>  |                               |                                | Dated: <b>9/21/2005</b>  |                               |                                      |  |
| Jack P. Friedman<br>Reg. No. 44,688<br>Schmeiser, Olsen & Watts<br>3 Lear Jet Lane, Suite 201<br>Latham, NY 12110<br>(518) 220-1850   |                               |                                | <div style="border: 1px solid black; padding: 5px;">I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on<br/><br/>_____<br/>(Date)<br/><br/>_____<br/>Signature of Person Mailing Correspondence<br/><br/>_____<br/>Typed or Printed Name of Person Mailing Correspondence</div> |                               |                                      |  |
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SEP 21 2005

DOCKET NO. RSW920010033US1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Doreen L. Galli

Examiner: Kang, Insun

Serial No.: 09/870,223

Art Unit: 2193

Filed: 05/30/2001

**For: METHOD AND APPARATUS FOR TAILORING VOICE PROMPTS OF AN  
INTERACTIVE VOICE RESPONSE SYSTEM**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**BRIEF OF APPELLANT**

This Appeal Brief, pursuant to the Notice of Appeal filed July 21, 2005, is an appeal from the rejection of the Examiner in the Office Action dated March 25, 2005.

**REAL PARTY IN INTEREST**

International Business Machines, Inc. is the real party in interest.

**RELATED APPEALS AND INTERFERENCES**

None.

**STATUS OF CLAIMS**

Claims 1-16 are rejected. This Appeal Brief is in support of an appeal from the rejection of claims 1-16.

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### STATUS OF AMENDMENTS

There are no After-Final Amendments which have not been entered.

### SUMMARY OF CLAIMED SUBJECT MATTER

The present invention provides an interactive voice response system comprising: an application program that provides call flow instructions, wherein a call flow instruction that invokes a voice prompt provides a variable that can be read from outside compiled code of the application program; a programmable processor that executes the call flow instructions of the application program; a database that contains a plurality of pre-recorded voice prompts; and an assignment table that assigns a value to the variable to provide an entry point to the database. See specification, page 6, lines 1-17.

The present invention provides method for selecting a voice prompt of an interactive voice response system that operates according to the compiled code of an application program that provides call flow instructions for the interactive voice response system. a variable associated with the voice prompt by the application program is provided. A value is assigned to the variable by accessing an assignment table that is held outside the compiled code of the application program. A database record is read, wherein the database record includes a digitally encoded voice prompt, wherein the database record is identified by the value assigned to the variable. See specification, page 6, line 18 - page 7, line 6.

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The database may include a first voice prompt in a first language and a second voice prompt in a second language, wherein the first language and the second language are different. See specification, page 7, line 20 - page 8, line 4.

The database may include a first voice prompt spoken by a first speaker and a second voice prompt spoken by a second speaker, wherein the first speaker and the second speaker are different (e.g., the first voice prompt spoken by a male speaker and the second voice prompt spoken by a female speaker; the first voice prompt having a first level of formality and the second voice prompt having a second level of formality such that the first level of formality and the second level of formality are different). See specification, page 7, lines 14-19.

The database may include a voice prompt that includes music and/or audio tone. See specification, page 7, lines 9-13.

The database may include a first voice prompt and a second voice prompt spoken by the same speaker, wherein the first voice prompt and the second voice prompt convey the same meaning, and wherein the first voice prompt and the second voice prompt differ in wording. See specification, page 7, line 20 - page 8, line 4.

#### **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

1. Claims 1-2 and 9-10 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Osder *et al.* (US Patent 5,493,606).

2. Claims 3-8 and 11-16 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable

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over Osler *et al.* (US Patent 5,493,606).

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## ARGUMENT

### GROUND OF REJECTION 1

Claims 1-2 and 9-10 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Osder *et al.* (US Patent 5,493,606).

Appellant respectfully contends that Osder does not anticipate claim 1, because Osder does not teach each and every feature of claim 1.

#### Claims 1-2

Appellant contends that Osder does not teach the following feature of claim 1: "an application program that provides call flow instructions, wherein a call flow instruction that invokes a voice prompt provides a variable that can be read from outside compiled code of the application program; ... ; a database that contains a plurality of pre-recorded voice prompts; and an assignment table that assigns a value to the variable to provide an entry point to the database.

Osder, col. 1, lines 48-57 defines and illustrates a "prompt" as follows: "A prompt is composed of and defined by a sequence of static and dynamic elements. A static element denotes a fixed phrase, whereas a dynamic element provides a location in the prompt for variable data to be provided by the Network Application at run time. For example, in the prompt "you have <number> new messages", the phrases "you have" and "new messages" are static elements whereas <number> is a dynamic element to be provided by the Network Application in accordance with the conditions at run time. "

Osder (col. 6, line 61 - col. 7, line 3) in relation to FIG. 3 explains as follows how a

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prompt is generated in order to be played by a Network Application: "When the Network Application desires to play prompt P1000 in American English, the Network Application issues an ESP or EMSP command identifying SPIN application UV10AE and prompt P1000 and providing the run time dynamic data for the <DYN3> and <DYN1> dynamic elements. The cardinal number dynamic element is **expanded** utilizing the **MDDP DYN3 procedure** together with the Dynamic Element Table 5. The date and time dynamic element is **expanded** utilizing the **MDDP DYN1 procedure** together with the Dynamic Element Table 5" (emphasis added).

Further, Osder (col. 6, lines 54-60) explains the role of Table 3 in FIG. 3 and the relationship of Table 3 to Table 5: "An American English Prompt Set 2 lists the prompts of the American English SPIN application UV10AE. A Prompt Definition Table 3 illustrates the definition or mapping for the prompt P1000 which has two dynamic elements <DYN3> and <DYN1>. The SPIN application UV10AE utilizes American English MDDP 4 together with American English Dynamic Element Table 5 in the **expansion** of the dynamic data" (emphasis added).

For the sake of argument, assume that Tables 3 and 5 of FIG. 3 of Osder is the "database" of claim 1. The prompt identifier P1000 is provided in the call flow instruction of the Network Application that invokes the voice prompt associated with P1000. Note from FIG. 3 that P1000 points to Table 3. Table 3 contains the static elements ('YOU HAVE' and 'NEW MESSAGES. FIRST MESSAGE SENT ') of the prompt. Table 3 also identifies MDDP procedures DYN3 and DYN4 which need to be executed to "expand" the cardinal number dynamic elements <DYN3> and <DYN5>, respectively, of the prompt. Table 5 is a table that stores the data from

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which the cardinal number dynamic elements <DYN3> and <DYN5> may be expanded.

Therefore, Osder does not teach "a database that contains a plurality of pre-recorded voice prompts", since Tables 3 and 5 do not contain the prompt associated with P1000. It is only at run time when MDDP procedures DYN3 and DYN4 are executed to "expand" the cardinal number dynamic elements <DYN3> and <DYN5>, respectively, of the prompt (including use of Table 5) to generate the prompt in accordance with the prescription of Table 3. Furthermore, Osder does not teach that the run-time generated prompt pertaining to P1000 is stored in a database, as required by claim 1. Osder teaches only that the generated prompt is "played".

In addition, Osder does not teach "an assignment table that assigns a value to the variable to provide an entry point to the database". If P1000 is the "variable" then its value is either the prompt itself or a pointer to Table 3. If the value of P1000 is the prompt itself, then Appellant argues that Osder does not disclose a table that assigns the prompt itself to P1000 (as required by claim 1), but instead teaches that the value of P1000 is the generated prompt resulting from execution of MDDP procedures DYN3 and DYN4. If the value of P1000 is a pointer to Table 3, then Appellant argues that Osder does not disclose a table that assigns (to P1000) a pointer to Table 3, as required by claim 1.

Based on the preceding arguments, Appellant respectfully maintains that Osder does not anticipate claim 1, and that claim 1 is in condition for allowance. Since claim 2 depends from claim 1, Appellant contends that claim 2 is likewise in condition for allowance.

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Claims 9-10

With respect to claim 9, the Examiner states: "Per claim 9, it is the method version of claim 1, respectively, and is rejected for the same reasons set forth in connection with the rejection of claim 1 above."

In response, Appellant traverses the rejection of claim 9 based on Appellant's arguments presented *supra* in conjunction with claim 1 in relation to the rejection under 35 U.S.C. §102(b).

In addition, Appellant contends that Osder does not teach the following feature of claim 9: "reading a database record that includes a digitally encoded voice prompt, wherein the database record is identified by the value assigned to the variable".

First, Appellant's discussion *supra* of claim 1 explained how the static elements of P1000 are contained in Table 3 and data relating to the dynamic elements are stored in Table 5 of FIG. 3 of Osder. However, claim 9 requires that the prompt (which includes both the static and dynamic records) be included in "a database record" (i.e., in one database record), which is logically impossible in Osder since Osder teaches the static elements and the dynamic element data are stored in different tables (i.e., in Tables 3 and 5, respectively).

Second, Osder does not teach "wherein the database record is identified by the value assigned to the variable", because if the value of the variable P1000 is the prompt itself then Applicant argues that the prompt itself does not identify a database record.

Based on the preceding arguments, Appellant respectfully maintains that Osder does not

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anticipate claim 9, and that claim 9 is in condition for allowance. Since claim 10 depends from claim 9, Appellant contends that claim 10 is likewise in condition for allowance.

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**GROUND OF REJECTION 2**

Claims 3-8 and 11-16 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Osder *et al.* (US Patent 5,493,606).

Since claims 3-8 depend from claim 1, which Appellant have argued *supra* to be patentable under 35 U.S.C. §102 over Osder, Appellant maintains that claims 3-8 are not unpatentable under 35 U.S.C. §103(a) over Osder.

Since claims 11-16 depend from claim 9, which Appellant has argued *supra* to be patentable under 35 U.S.C. §102 over Osder, Appellant maintains that claims 11-16 are not unpatentable under 35 U.S.C. §103(a) over Osder.

In addition with respect to claims 3-8 and 11-16, Appellant respectfully contends that the Examiner's argument for modifying Osder by features specific to claims 3-8 and 11-16 is not persuasive.

**Claims 3 and 11**

Appellant asserts that Osder does not teach or suggest the following feature of claims 3 and 11: “”.

The Examiner argues: “Per claim 3: ... Osder does not explicitly teach that the database includes a first voice prompt spoken by a first speaker and a second voice prompt spoken by a second speaker, wherein the first speaker and the second speaker are different.

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However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include different voice prompts spoken by different speakers as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for different purposes" (emphasis added).

In response, Appellant respectfully contends that the Examiner has not supplied a legally persuasive argument as to why a person of ordinary skill in the art would modify Osder in relation to claims 3 and 11. In particular, established case law requires that the prior art must contain some suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. V. Cleveland Gulf Co.*, 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001 ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention"). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984 ("The mere fact that the prior art could be so modified would not have made the motivation obvious unless the prior art suggested the desirability of the modification.")). The Examiner has not made any showing of where the prior art suggests the modifications of Osder alleged by the Examiner to be obvious. Thus, the Examiner has provided a reason for the modification of Osder by speculation, and not by teachings of the prior art.

By not citing any suggestion or incentive in the prior art for the modifications of Osder

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alleged by the Examiner to be obvious, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claims 3 and 11.

Claims 4 and 12

Appellant asserts that Osder does not teach or suggest the following feature of claims 4 and 12: "wherein the database includes a first voice prompt spoken by a first speaker and a second voice prompt spoken by a second speaker, wherein the first speaker and the second speaker are different".

The Examiner argues: "Per claim 4: ... **Osder does not explicitly teach that the database includes a first voice prompt spoken by a male speaker and a second voice prompt spoken by a female speaker.** However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include different voice prompts spoken by male and female speakers as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for different preferences." (emphasis added).

In response, Appellant respectfully contends that the Examiner has not supplied a legally persuasive argument as to why a person of ordinary skill in the art would modify Osder in relation to claims 3 and 11. In particular, established case law requires that the prior art must contain some suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. V. Cleveland Gulf* 09/870,223

Co., 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001 ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention"). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984 ("The mere fact that the prior art could be so modified would not have made the motivation obvious **unless the prior art suggested the desirability of the modification.**"). The Examiner has not made any showing of where the prior art suggests the modifications of Osder alleged by the Examiner to be obvious. Thus, the Examiner has provided a reason for the modification of Osder by speculation, and not by teachings of the prior art.

By not citing any suggestion or incentive in the prior art for the modifications of Osder alleged by the Examiner to be obvious, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claims 4 and 12.

#### Claims 5 and 13

Appellant asserts that Osder does not teach or suggest the following feature of claims 5 and 13: "wherein the database includes a first voice prompt having a first level of formality and a second voice prompt having a second level of formality, wherein the first level of formality and the second level of formality are different".

The Examiner argues: "Per claim 5: ... **Osder does not explicitly teach that the database includes a first voice prompt having a first level of formality and a second voice**

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**prompt having a second level of formality, wherein the first level of formality and the second level of formality are different.** However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include different level of formality of voice prompts as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for different preferences.” (emphasis added).

In response, Appellant respectfully contends that the Examiner has not supplied a legally persuasive argument as to why a person of ordinary skill in the art would modify Osder in relation to claims 3 and 11. In particular, established case law requires that the prior art must contain some suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. V. Cleveland Gulf Co.*, 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001 (“In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention”). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984 (“The mere fact that the prior art could be so modified would not have made the motivation obvious **unless the prior art suggested the desirability of the modification.**”). The Examiner has not made any showing of where the prior art suggests the modifications of Osder alleged by the Examiner to be obvious. Thus, the Examiner has provided a reason for the modification of Osder by speculation, and not by teachings of the prior art.

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By not citing any suggestion or incentive in the prior art for the modifications of Osder alleged by the Examiner to be obvious, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claims 5 and 13.

Claims 6 and 14

Appellant asserts that Osder does not teach or suggest the following feature of claims 6 and 14: "wherein the database includes a voice prompt that includes music".

The Examiner argues: "Per claim 6: ... **Osder does not explicitly teach that the database includes a voice prompt that includes music.** However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include music voice prompts as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for different preferences." (emphasis added).

In response, Appellant respectfully contends that the Examiner has not supplied a legally persuasive argument as to why a person of ordinary skill in the art would modify Osder in relation to claims 3 and 11. In particular, established case law requires that the prior art must contain some suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. V. Cleveland Gulf Co.*, 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references

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and combine them in a way that would produce the claimed invention"). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the motivation obvious **unless the prior art suggested the desirability of the modification.**"). The Examiner has not made any showing of where the prior art suggests the modifications of Osder alleged by the Examiner to be obvious. Thus, the Examiner has provided a reason for the modification of Osder by speculation, and not by teachings of the prior art.

By not citing any suggestion or incentive in the prior art for the modifications of Osder alleged by the Examiner to be obvious, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claims 6 and 14.

#### Claims 7 and 15

Appellant asserts that Osder does not teach or suggest the following feature of claims 7 and 15: "wherein the database includes a voice prompt that includes an audio tone".

The Examiner argues: "Per claim 7: ... **Osder does not explicitly teach that the database includes a voice prompt that includes an audio tone.** However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include audio tone of voice prompts as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for different preferences." (emphasis added).

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In response, Appellant respectfully contends that the Examiner has not supplied a legally persuasive argument as to why a person of ordinary skill in the art would modify Osder in relation to claims 3 and 11. In particular, established case law requires that the prior art must contain some suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. V. Cleveland Gulf Co.*, 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention"). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the motivation obvious **unless the prior art suggested the desirability of the modification.**"). The Examiner has not made any showing of where the prior art suggests the modifications of Osder alleged by the Examiner to be obvious. Thus, the Examiner has provided a reason for the modification of Osder by speculation, and not by teachings of the prior art.

By not citing any suggestion or incentive in the prior art for the modifications of Osder alleged by the Examiner to be obvious, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claims 7 and 15.

Claims 8 and 16

Appellant asserts that Osder does not teach or suggest the following feature of claims 8

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and 16: "wherein the database includes a first voice prompt and a second voice prompt spoken by the same speaker, wherein the first voice prompt and the second voice prompt convey the same meaning, and wherein the first voice prompt and the second voice prompt differ in wording".

The Examiner argues: "Per claim 8: ... **Osder does not explicitly teach that the database includes a first voice prompt and a second voice prompt spoken by the same speaker, wherein the first voice prompt and the second voice prompt convey the same meaning, and wherein the first voice prompt and the second voice prompt differ in wording.** However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include various voice prompts such as including a dialect as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for different preferences." (emphasis added).

In response, Appellant respectfully contends that the Examiner has not supplied a legally persuasive argument as to why a person of ordinary skill in the art would modify Osder in relation to claims 3 and 11. In particular, established case law requires that the prior art must contain some suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. V. Cleveland Gulf Co.*, 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001 ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching **in the prior art** that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention"). See also *In re Gordon*, 09/870,223

733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984 ("The mere fact that the prior art could be so modified would not have made the motivation obvious **unless the prior art suggested the desirability of the modification.**"). The Examiner has not made any showing of where the prior art suggests the modifications of Osder alleged by the Examiner to be obvious. Thus, the Examiner has provided a reason for the modification of Osder by speculation, and not by teachings of the prior art.

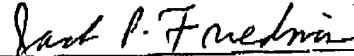
By not citing any suggestion or incentive in the prior art for the modifications of Osder alleged by the Examiner to be obvious, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claims 8 and 16.

09/870,223

SUMMARY

In summary, Appellant respectfully requests reversal of the March 25, 2005 Office Action rejection of claims 1-16.

Respectfully submitted,



Jack P. Friedman  
Attorney For Appellant  
Registration No. 44,688

Dated: 09/21/2005

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Applicant: Doreen L. Galli

Examiner: Kang, Insun

SEP 21 2005

Serial No.: 09/870,223

Art Unit: 2193

Filed: 05/30/2001

For: METHOD AND APPARATUS FOR TAILORING VOICE PROMPTS OF AN  
INTERACTIVE VOICE RESPONSE SYSTEM

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

APPENDIX A - CLAIMS ON APPEAL

1. An interactive voice response system, comprising:

an application program that provides call flow instructions, wherein a call flow instruction that invokes a voice prompt provides a variable that can be read from outside compiled code of the application program;

a programmable processor that executes the call flow instructions of the application program;

a database that contains a plurality of pre-recorded voice prompts; and

an assignment table that assigns a value to the variable to provide an entry point to the database.

2. The interactive voice response system of claim 1, wherein the database includes a first voice

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prompt in a first language and a second voice prompt in a second language, wherein the first language and the second language are different.

3. The interactive voice response system of claim 1, wherein the database includes a first voice prompt spoken by a first speaker and a second voice prompt spoken by a second speaker, wherein the first speaker and the second speaker are different.

4. The interactive voice response system of claim 1, wherein the database includes a first voice prompt spoken by a male speaker and a second voice prompt spoken by a female speaker.

5. The interactive voice response system of claim 1, wherein the database includes a first voice prompt having a first level of formality and a second voice prompt having a second level of formality, wherein the first level of formality and the second level of formality are different.

6. The interactive voice response system of claim 1, wherein the database includes a voice prompt that includes music.

7. The interactive voice response system of claim 1, wherein the database includes a voice prompt that includes an audio tone.

8. The interactive voice response system of claim 1, wherein the database includes a first voice prompt and a second voice prompt spoken by the same speaker, wherein the first voice prompt



and the second voice prompt convey the same meaning, and wherein the first voice prompt and the second voice prompt differ in wording.

9. A method for selecting a voice prompt of an interactive voice response system that operates according to the compiled code of an application program that provides call flow instructions for the interactive voice response system, the method comprising the steps of:

providing a variable associated with the voice prompt by the application program;

assigning a value to the variable by accessing an assignment table that is held outside the compiled code of the application program; and

reading a database record that includes a digitally encoded voice prompt, wherein the database record is identified by the value assigned to the variable.

10. The method of claim 9, wherein the database includes a first voice prompt in a first language and a second voice prompt in a second language, wherein the first language and the second language are different.

11. The method of claim 9, wherein the database includes a first voice prompt spoken by a first speaker and a second voice prompt spoken by a second speaker, wherein the first speaker and the second speaker are different.

12. The method of claim 9, wherein the database includes a first voice prompt spoken by a male speaker and a second voice prompt spoken by a female speaker.

13. The method of claim 9, wherein the database includes a first voice prompt having a first level of formality and a second voice prompt having a second level of formality, wherein the first level of formality and the second level of formality are different.

14. The method of claim 9, wherein the database includes a voice prompt that includes music.

15. The method of claim 9, wherein the database includes a voice prompt that includes an audio tone.

16. The method of claim 9, wherein the database includes a first voice prompt and a second voice prompt spoken by the same speaker, wherein the first voice prompt and the second voice prompt convey the same meaning, and wherein the first voice prompt and the second voice prompt differ in wording.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Doreen L. Galli

Examiner: Kang, Insun

Serial No.: 09/870,223

Art Unit: 2193

Filed: 05/30/2001

For: **METHOD AND APPARATUS FOR TAILORING VOICE PROMPTS OF AN  
INTERACTIVE VOICE RESPONSE SYSTEM**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**APPENDIX B - EVIDENCE**

There is no evidence entered by the Examiner and relied upon by Appellant in this appeal.

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**APPENDIX C - RELATED PROCEEDINGS**

There are no proceedings identified in the "Related Appeals and Interferences" section.

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